UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/681,476	ROTHMAN ET AL.
	Examiner	Art Unit
	DAVID FABER	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 October 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-52</u> is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-52</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>08 October 2003</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the application filed on 8 October 2003.

This office action is made Non Final.

2.   Claims 1-52 are pending.

Drawings

3.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4)

because reference character "20" has been used to designate both network and

system. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as

either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings

will not be held in abeyance.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claims 1-8, and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

6.   Claims 1-8, and 19-25 are rejected under 35 U.S.C. 112, second paragraph,

since it appears to be a hybrid claim. See Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat.

App. & Inter. 1990). The preamble claims a computer program, but the body of the claim

refers to the method steps ("providing", "assigning", etc). This renders the claim

indefinite, since it is unclear what the claimed subject matter is.

7.   The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

> An element in a claim for a combination may be expressed as a means or step for
> performing a specified function without the recital of structure, material, or acts in support
> thereof, and such claim shall be construed to cover the corresponding structure, material,
> or acts described in the specification and equivalents thereof.

8.   As per independent Claims 17, 33, and 51, Claims 17, 33, and 51 are rejected

since the claim recites the limitation "means for receiving…, means for determining…,

means for assembling…" Examiner is unsure if the means for is referring to any

hardware since apparatus is still referring to software, pro se.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

10.   Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material
Per Se or Computer Programs Representing Computer Listings Per Se
Data structures not claimed as embodied in computer-readable media are descriptive
material per se and are not statutory because they are not capable of causing functional
change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760
(claim to a data structure per se held nonstatutory). Such claimed data structures do not
define any structural and functional interrelationships between the data structure and other
claimed aspects of the invention which permit the data structure's functionality to be
realized. In contrast, a claimed computer-readable medium encoded with a data
structure defines structural and functional interrelationships between the data structure
and the computer software and hardware components which permit the data structure's
functionality to be realized, and is thus statutory.
Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or
expressions of the programs, are not physical "things." They are neither computer
components nor statutory processes, as they are not "acts" being performed. Such
claimed computer programs do not define any structural and functional interrelationships
between the computer program and other claimed elements of a computer which permit
the computer program's functionality to be realized. In contrast, a claimed computer-
readable medium encoded with a computer program is a computer element which defines
structural and functional interrelationships between the computer program and the rest of
the computer which permit the computer program's functionality to be realized, and is
thus statutory. Accordingly, it is important to distinguish claims that define descriptive
material per se from claims that define statutory inventions.
Computer programs are often recited as part of a claim. Office personnel should
determine whether the computer program is being claimed as part of an otherwise
statutory manufacture or machine. In such a case, the claim remains statutory irrespective
of the fact that a computer program is included in the claim. The same result occurs when
a computer program is used in a computerized process where the computer executes the
instructions set forth in the computer program. Only when the claimed invention taken as
a whole is directed to a mere program listing, i.e., to only its description or expression, is it
descriptive material per se and hence nonstatutory.
**Since a computer program is merely a set of instructions capable of being executed by a
computer, the computer program itself is not a process and Office personnel should treat
a claim for a computer program, without the computer-readable medium needed to realize
the computer program's functionality, as nonstatutory functional descriptive material.
When a computer program is claimed in a process where the computer is executing the
computer program's instructions, Office personnel should treat the claim as a process
claim. See paragraph IV.B.2(b), below. When a computer program is recited in
conjunction with a physical structure, such as a computer memory, Office personnel
should treat the claim as a product claim.**

11.   Claims 1-8, 17, 18, 19-25, 33-34, and 51-52 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter. The claims

appear to be claiming "software systems" i.e. systems without hardware indication,

which is a computer program per se. Since the claims disclose computer program per

se that is not embodied on a computer readable medium, they appear non-statutory.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13.   Claims 1-5, 9-13, 17-22, 26-29, 33-39, 43-47, and 51-52 are rejected under 35

U.S.C. 102(b) as being anticipated by Landsman et al (US Patent 6,317,761, published

11/13/2001).

As per independent claim 1, Landsman et al discloses a system/method

comprising:

- receiving a creative definition; (Column 3, lines 45-61; Column 17, lines 37-
  52)

- determining if the creative definition is a programmable or non-programmable
  creative definition; (Column 3, lines 45-61; Column 17, lines 37-52: Browser
  has the ability to determine if the embedded code is a banner or is a
  javascript program)

- assembling, if the creative definition is a non-programmable creative, the non-
  programmable creative; and (Column 3, lines 45-61: Discloses obtaining the
  graphic to be rendered)

- executing, if the creative definition is a programmable creative, the programmable creative definition to generate the creative. (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement)

As per dependent claim 2, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of periodically executing the programmable creative definition responsive to a request generated by an advertising system. (Col 17, lines 7-21, Column 18, lines 38-49: Discloses the advertising system generating a request to download the advertisement based on the URL provided, wherein an applet is then executed to download the advertisement)

As per dependent claim 3, Landsman et al discloses wherein the step of executing the programmable creative definition to generate the creative includes the step of retrieving, responsive to the 20 programmable creative definition, data from the server-side system. (Col 16, line 53 – Col 17, line 21)

As per dependent claim 4, Landsman et al discloses wherein the data is proprietary data. (Column 21, lines 46-60: Discloses data being streamed proprietary, thus the data being proprietary data)

As per dependent claim 5, Landsman et al discloses including the step of transmitting the creative to a web server for transmission to an end-user. (i.e. Col 16, line 53- Col 17, line 21: Advertisement is downloaded from the server to the client)

As per independent claim 9, Claim 9 recites similar limitations as in Claim 1 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 10, Claim 10 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 11, Claim 11 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 12, Claim 12 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 17, Claim 17 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 18, Claim 18 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 19, Landsman et al discloses a method compromising:

- storing a first definition for a non-programmable creative; (Column 3, lines 45-61: Discloses embedding HTML code in a web page to generate a banner)

- storing a second definition for a programmable creative including a program for generating the programmable creative; (Column 17, lines 37-52: Discloses embedding a special HTML advertising tag that contains a URL to a Javascript program)

- executing the first definition to generate a non-programmable creative; storing the non-programmable creative; (Column 3, lines 45-61: When the HTML code is interpreted by the client's browser, it fetches and downloads the banner to the client's browser to be rendered to the client. The banner is stored on a server and in the client's browser when retrieved)

- executing the second definition to generate a programmable creative; storing the programmable creative (Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag and executing the JavaScript code associated with the advertisement, wherein the advertisement is stored at the server, or at the client's browser)

- receiving a request to transmit a creative to a viewer; selecting, by an advertising system responsive to the request, the programmable creative or the non-programmable creative; and transmitting the selected programmable creative or non-programmable creative to the viewer. Column 17, lines 37- Col 20, line 17: Discloses reading the advertising tag, executing the JavaScript code associated with the advertisement ,generating a request to download the advertisement based on the URL provided, wherein an applet is then executed to download the advertisement which the advertisement is downloaded from the server to the client)

As per dependent claim 20, Landsman et al discloses the step of executing the second definition to generate a programmable creative includes the step of periodically executing the second definition to generate an updated programmable creative. (Col 20, lines 24-28; 40-49; 15-42)

As per dependent claim 21, Claim 21 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 22, Claim 22 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 26, Claim 26 recites similar limitations as in Claim 19 and is rejected under similar rationale. Furthermore, Landsman et al discloses a processor and memory. (Column 39, lines 39-45)

As per dependent claim 27, Claim 27 recites similar limitations as in Claim 20 and is rejected under similar rationale.

As per dependent claim 28, Claim 28 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 33, Claim 33 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 34, Claim 34 recites similar limitations as in Claim 19 and is rejected under similar rationale.

As per independent claim 35, Claim 35 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 36, Claim 36 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 37, Claim 37 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 38, Claim 38 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 39, Claim 39 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 43, Claim 43 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per dependent claim 44, Claim 44 recites similar limitations as in Claim 2 and is rejected under similar rationale.

As per dependent claim 45, Claim 45 recites similar limitations as in Claim 3 and is rejected under similar rationale.

As per dependent claim 46, Claim 46 recites similar limitations as in Claim 4 and is rejected under similar rationale.

As per dependent claim 47, Claim 47 recites similar limitations as in Claim 5 and is rejected under similar rationale.

As per independent claim 51, Claim 51 recites similar limitations as in Claim 1 and is rejected under similar rationale.

As per independent claim 52, Claim 52 recites similar limitations as in Claim 1 and is rejected under similar rationale.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.   Claims 6-8, 14-16, 23-25, 30-32, 40-42, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US Patent 6,317,761, published 11/13/2001) in further view of Galomb (US PGPub 20010039510, published 11/8/2001)

As per dependent claims 6-8, Landsman et al discloses the ability for an advertiser to change or update any of its advertisements by just modifying appriopate media and AdDescriptor files that reside in the third-party advertising management

system. (Column 13, lines 55-66) However, Landsman et al fail to specifically disclose periodically changing text, an image, or a hyperlink within the creative. However, Galomb discloses advertisement includes text, images, and/or hyperlinks. (Paragraph 0004) Thus, in conjunction of Landsman et al with Galcomb, an advertiser would have the ability to change its advertisements by modifying the text, image or hyperlink associated with the advertisement.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modify Landsman et al with Galomb's advertising system to enable since it would have provided the benefit of the need for advertisers to directly and instantly control the testing and optimizing of their advertisements.

As per dependent claims 14-16, Claims 14-16 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 23-25, Claims 23-25 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 30-32, Claims 30-32 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 40-42, Claims 40-42 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

As per dependent claims 48-50, Claims 48-50 recites similar limitations as in Claim 6-8 and is rejected under similar rationale.

Conclusion

16.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Doemling et al (US PGPub 20050038700): Discloses creating advertisments.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

/David Faber/
Examiner, Art Unit 2178

/CESAR B PAULA/

Primary Examiner, Art Unit 2178